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5. How far one may be liable to those who are injured in coming upon his premises under license of the law is a question not discussed in the books. Suppose, for example, that a traveller finds the highway impassible, and in passing around the obstruction on private grounds, as he lawfully may, he falls into an unguarded pit, can the owner of the land be held liable for his injury? Or an officer enters his house to serve a writ, and is precipitated through a trap-door, can the owner be made responsible as for negligence? The question is one of no little interest; for while the party injured is in the exercise of a legal right, it must be conceded that the other, as a general rule, may leave his premises in any condition he pleases, provided he does nothing, expressly or by implication, to bring others into danger upon them. It was

held in *Laverone v. Maugianti*, 41 Cal. 138, that one who keeps a vicious dog, as a watch-dog, is liable to one who, by accident, is put within the dog's reach and is injured; but that was upon the ground that he had no right to keep the vicious dog at all. But doubtless a man may keep a dangerous dog upon his premises as lawfully as any other danger, if he gives due warning to those who might come within his reach: see *Sarch v. Blackburn*, 4 C. & P. 297; *Curtis v. Mills*, 5 Id. 489. But beyond any question, we should say, he would be liable to one who, visiting his premises by license of the law, should be assailed by a vicious animal of any sort, kept by the owner with knowledge of his vicious propensity: see *Blackman v. Simmons*, 3 C. & P. 138; *Sherfey v. Bartley*, 4 Sneed 58; *Loomis v. Terry*, 17 Wend. 496. T. M. C.

U. S. Circuit Court, Eastern District of Wisconsin.

B. LEIDERSDORF ET AL. v. J. G. FLINT.

The maker of a trade-mark is neither an author nor an inventor, and a trade-mark is neither a writing nor a discovery, within the meaning of the provision of the Constitution giving to Congress jurisdiction over the subject of copyrights and patents.

Congress, therefore, has no jurisdiction over the subject of trade marks, and so much of title 60 of the Revised Statutes as relates to trade-marks is unconstitutional and void.

IN EQUITY. This was a bill for an injunction to restrain an alleged infringement by defendant of complainants' trade-mark, used upon packages of tobacco, and registered according to act of Congress. Both complainants and defendant were citizens of Wisconsin, and the bill was based upon that provision of section 4942, Revised Statutes, which gives to a party aggrieved by the wrongful use of his trade-mark, a remedy by injunction, according to the course of equity, in any court having jurisdiction over the person guilty of such wrongful use, and was filed upon the theory that this court had jurisdiction to entertain such a bill, though both parties are citizens of the same state.

Carpenter & Smiths, for complainant.

Jenkins, Elliott & Winkler, for defendant.

The opinion of the court was delivered by

DYER, J.—The bill is demurred to on the ground that the court has no jurisdiction, and the demurrer raises the question of the constitutional power of Congress to legislate upon the subject of trade-marks. The question is important, and appears to be new, since, with the exception of *Duwell v. Bohmer*, 10 C. L. N. 356, we were referred, upon the argument, to no reported case in which it has been determined.

The statutory provisions relating to trade-marks are contained in Title 60, Revised Statutes, which is entitled, "Patents, trade-marks, and copyrights." They authorize the registration of trade-marks, impose restrictions upon such registration, and confer certain remedies for the protection of the rights of parties who have complied with the requirements of the statute. The remedies thus given are mentioned in section 4942, which provides that "any person who shall reproduce, counterfeit, copy or imitate any recorded trade-mark, and affix the same to goods of substantially the same descriptive properties and qualities as those referred to in the registration, shall be liable to an action on the case for damages, for such wrongful use of such trade-mark, at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity, to enjoin the wrongful use of his trade-mark, and to recover compensation therefor, in any court having jurisdiction over the person guilty of such wrongful use."

The only clause in the Constitution from which it can be claimed Congress derives its power to legislate upon the subject, is art. 1, sect. 8, clause 8, which authorizes Congress "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." If the power in question is given by this clause of the Constitution, then, inasmuch as by section 629 of the Revised Statutes the Circuit Courts are invested with original jurisdiction of all suits at law or in equity arising under the patent or copyright laws of the United States, and in view of the act of Congress of March 3d 1875, which confers jurisdiction in all civil cases arising under any law of the United States where the amount

in dispute exceeds \$500, and of the provisions of section 4942, Revised Statutes, above referred to, there is ground for claiming that the United States courts have jurisdiction in suits which involve the right to trade-marks, without regard to the citizenship of parties.

But in contending that the power to legislate upon the subject of trade-marks is derived from the constitutional provision before cited, it must be necessarily assumed, that the maker of a trade-mark is an author or inventor, and that a trade-mark is a writing or discovery within the meaning of that clause.

Argument, we think, can hardly be needed to demonstrate that a law regulating trade-marks is not in any just sense a copyright law. The general meaning of the term copyright is an author's exclusive right of property in the work which he produces. It includes the right of the citizen who is an author of any book or writing, any literary, dramatic or musical composition, any engraving, painting, drawing, map, chart or print, and of models or designs intended as works of art. It is something which appertains to authors who, by their writings and designs, promote the advancement of literature, science and the useful arts. An author, by standard definition, is "one who produces, creates or brings into being; the beginner, former or first mover of anything; hence the efficient cause of a thing." The term is appropriately applied to one who composes or writes a book "or writing," and in a more general sense, to one whose occupation is to compose and write books "or writings."

So, too, invention implies originality. Originality, not merely mechanical dexterity, is the test of invention: *Blake v. Stafford*, 3 Fisher 305. It is the "finding out, contriving, creating of something which did not exist, and was not known before, and which can be made useful and advantageous in the pursuits of life, or which can add to the enjoyments of mankind:" *Conover v. Roach*, 4 Fisher 16; *Ransom v. Mayor of N. Y.*, 1 Fisher 264. "To entitle one to the character of an inventor, he must himself have conceived the idea embodied in his improvement. It must be the product of his own mind and genius:" *Pitts v. Hall*, 2 Blatchf. 234.

The dissimilar characteristics of trade-marks and copyrights, and inventions for which patents may be granted, have been pointed out or illustrated in various adjudicated cases. A trade-mark has been very well defined as one's commercial signature to

his goods. It may consist of a name, symbol, figure, letter, form or device, if adopted and used by a manufacturer or merchant, in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, so that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry and fidelity: *McLean v. Fleming*, 6 Otto 254; *Upton*, Trade Marks 9; *Taylor v. Carpenter*, 2 Sandf. 603.

The basis of trade-mark right is, primarily, the encouragement of trade. As the court in discussing the subject say, in *Partridge v. Mench*, 2 Paige 103, the question in such a case is not whether a person was the original inventor or proprietor of the article made by him and upon which he puts his trade-mark, nor whether the article made and sold by another, under his trade-mark, is an article of the same quality or value. But the court proceeds upon the ground that the complainant has a valuable interest in the good-will of his trade or business, and that having appropriated to himself a particular label or sign or trade-mark, indicating that the article is manufactured or sold by him or by his authority, or that he carries on his business at a particular place, he is entitled to protection against any other person who pirates upon the good-will of his customers, or of the patrons of his trade or business, by sailing under his flag without his authority or consent.

The name, word, mark, device or symbol constituting a trade-mark, may be devoid of novelty, originality, and of anything partaking of the nature of invention. As the Supreme Court say, in *Canal Company v. Clark*, 13 Wall. 322, undoubtedly words or devices may be adopted as trade-marks which are not originally inventions of him who adopted them. Property in a trade-mark, or, rather, in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions. Words in common use, with some exceptions, may be adopted, if, at the time of their adoption, they were not employed to designate the same or like articles of production. So, in *McLean v. Fleming*, *supra*, it is said that trade-marks are not required to be new, and may not involve the least invention or skill in their application or discovery.

As is well shown by a writer who has, with evident care, collected the authorities on this subject, vol. 7, C. L. J. 143, the foundation of title to a trade-mark is priority of adoption and

actual use in trade, and it neither in application nor discovery necessarily possesses the elements of originality, novelty or invention. The power given to Congress to promote the progress of science and useful arts is restricted to the rights of *authors* and *inventors*, and further, their rights are only to be secured for a *limited time*: *Livingston v. Van Ingen*, 9 Johns. 566. This limitation in time is imposed by the constitutional provision itself. But the right to a trade-mark is of common-law origin, and as a common-law right is limited only by the period of its use, and ceases only with its abandonment. Property in inventions and discoveries did not exist at common law, and for their protection we have to look wholly to the constitutional provision on the subject.

The consideration for which a grant is made by the public to the author of a new and useful invention, of an exclusive right, is the benefit resulting to the public from the invention. The consent of the inventor to make his invention known and available to others, and ultimately to give it to the public, constitutes the consideration for which he is entitled to receive protection from the government in the form of the grant of an exclusive right: Curtis on Patents, preface. Not so with trade-marks; for when the exclusive right to use a trade-mark terminates, no corresponding benefit results to the public. Its value is gone when it ceases to be exclusive and becomes the property of the public.

Mr. Browne, in his treatise on Trade-Marks, says: "The rights of inventors and authors, as long settled in Great Britain, were familiar to the framers of the Constitution; and as Mr. Justice STORY says, it is doubtless to this knowledge of the common law, and statutable rights of authors and inventors, that we are to attribute the constitutional provision being beneficial to all parties. It was beneficial to authors and inventors because it maintained their rights to the product of their intellectual labor; and beneficial to the public, as it would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions, without restraint. In short, the only boon which could be offered to inventors to disclose the secrets of their discoveries, would be the exclusive right and profit of them, as monopoly for a limited period. A copyright is limited by time; a trade-mark is not. A copyright is limited territorially; but a trade-mark acknowledges no boundaries. They are unlike in their natures."

In every aspect suggested, and in other respects which might be suggested, it would seem that the analogy between property in the use of a trade-mark and a patent for an invention, and between a trade-mark right and a copyright, fails. Property in a trade-mark exists independently of statute. It is otherwise with inventions and discoveries. They, as is said by the court in *Rodgers et al. v. Philip et al.*, 1 Off. Gaz. 31, "are protected only in consequence of the constitutional provision on the subject, which does not apply to trade-marks."

Considering with care the important question involved, and not unmindful that the question whether a law be void for repugnancy to the Constitution, or for want of constitutional authority to enact it, is at all times one of much delicacy, I am constrained to hold that legislation by Congress upon the subject of trade-marks is not authorized either by the letter or spirit of the constitutional provision from which such authority is sought to be deduced. The maker of a trade-mark is neither an author nor inventor, and a trade-mark is neither a writing nor a discovery, within the meaning and intent of the constitutional clause in question.

It may be added that the constitutionality of the trade-mark statute cannot be sustained under the clause which gives to Congress the power to regulate commerce among the several states, nor in my opinion, under any of the provisions of the Constitution which prescribe the legislative powers of Congress.

From these views it follows that this court is without jurisdiction to entertain the present controversy, which, as before stated, is between citizens of the same state.

Demurrer to bill sustained.

In this opinion Justice HARLAN, who sat at the hearing, concurred.

The importance of trade-marks and the value of the interests involved in them are shown by the increasing frequency of litigation in both state and national courts during the last few years. It is clear from the general current of such litigation and the professional efforts to get the cases into the courts of the United States, that both in the legal profession and in the business community there has been felt a want

of a more comprehensive and uniform, and perhaps more convenient and available jurisdiction over the subject than is afforded by the common law.

That this feeling was generally entertained, and that the Act of Congress was appreciated as in some degree a satisfaction of it, is shown by the large number of trade-marks registered under the act, amounting to nearly fifteen hundred a year, and apparently increas-

ing as the community was becoming familiar with the scope and usefulness of the statute.

The sudden breaking down, therefore, of this statute, for want of constitutional jurisdiction over the subject-matter by Congress, is a matter of very serious concern, not to say regret.

There seems, however, to be room for great doubt whether the control over patents and copyrights, given by the constitution to the national legislature, was intended by the framers of that instrument, or can be fairly held to cover a subject-matter presenting so many essential differences as that of trade-marks.

The only reported case on the subject, prior to the present, is *Duwell v. Bohmer*, 10 Chicago Leg. News 356. That was a bill for injunction in the Circuit Court of the United States, for the Southern District of Ohio. The defendants demurred, and assigned for ground of demurrer the want of jurisdiction in the court, the parties being all citizens of the same state, and "there being no act which confers upon the United States courts jurisdiction of the subject-matter in such a case." The stress of the argument in the case was upon the statutes giving jurisdiction to the circuit courts, and the nature of trade-marks as related to patents and copyrights did not receive the same amount of consideration as in the prin-

cipal case. But the point was clearly involved, and is so recognised by SWING, J., who says: "The copyright and trade-mark laws all come from the same source. So if the trade-mark law of 1870 be a copyright law, then the court has jurisdiction, without reference to residence or the amount in controversy." The learned judge then proceeds to review the laws, and sustains the jurisdiction upon the ground that the Act of 1870, being *in pari materia*, is a copyright law. The decision, therefore, as an authority, is in direct conflict with the principal case.

Since the principal case was decided, the same view has been announced in the Circuit Court for the Eastern District of Pennsylvania, in *Day et al. v. Walls*, 35 Legal Intelligencer 468. In that case a bill for injunction was, upon demurrer, dismissed for want of jurisdiction, the parties being all citizens of Pennsylvania. No opinion was delivered by the court, but CADWALADER, J., said that he entertained the same view as DYER, J., and had acted upon it in several cases previously.

The question may, therefore, be regarded as still unsettled, but the tendency and the weight of judicial opinion would seem to be against the validity of the legislation of Congress on the subject.

J. T. M.

Supreme Court of Kansas.

THE STATE OF KANSAS, EX REL. ATTORNEY-GENERAL, v. L. H. STEVENS ET AL.

Notwithstanding the records purporting to show a valid organization of a county may be forged, and the necessary facts in regard to such organization may not exist, yet any action of the legislative department of the state government subsequently recognising the existence of such organized county, will be effective to validate the organization.

A municipal corporation does not forfeit its corporate existence by non-user.